IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	:	Attorney Docket No. 2009_1195
Wei-Ping CHEN et al.	:	**Confirmation No. 4772**
Serial No. 10/586,204	:	Group Art Unit 1626
Filed September 29, 2006	:	Examiner Joseph R. Kosack
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REQUEST TO WITHDRAW FINALITY OF REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request that the finality of the rejection, as set forth in the Office Action of July 22, 2010, be withdrawn, based on the considerations set forth below.

Thus, Applicants take the position that the Examiner has misinterpreted the claims, and as a result, the final rejection is premature and should be withdrawn (see MPEP 706.07(d)).

1. On page 2 of the current Office Action, the Examiner argues that Applicants' argument that primarily one P-diastereomer is formed "*is immaterial for the simple reason in that this feature is not claimed by the instant claims.*"

This is not correct. During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification (MPEP 2111). Applicants, in the response filed March 29, 2010, already discussed this point in detail and concluded on page 3 that: "*The disclosure of the instant invention uses the wording "chiral" with the meaning of enantiopure throughout the description and experimental section.*" Thus, the feature "enantiopure" is already part of the claims.

In the alternative, it would be acceptable to amend instant claim 38 (main claim) on the basis of the overall description and especially based on paragraph [0063] (cf. line 4: "in enantiomeric excess") of the instant published application US 2008/0281106 A1, to read:

"38. A process for the production of chiral ligands in enantiomeric excess comprising: ... "

This paragraph in the specification states that in case a chiral ortho-directing group is used, and claim 38 so requires, a chiral phosphine in enantiomeric excess is obtained from direct synthesis.

2. Also on page 2 of the Office Action, the Examiner argues that: "*The instant claims are drawn to making a chiral ligand, but does not stale any particular location for the chirality to occur in the motecule.*"

This point of view is surprising, as claim 38 clearly indicates the "particular location(s)" due to the presence of:

a) X*, which is a chiral ortho-directing group, and in the ortho-position thereof the

b) P-chiral phosphine group having the formula $-PR^1R^{1'}$, wherein R^1 and $R^{1'}$ are different from each other (thus, P is chiral) is introduced, [and in addition

c) planar chirality (provided by the backbone)].

Thus, the "*particular location for the chirality to occur in the molecule*" is clearly given in claim 38.

In summary, Applicants take the position that the Examiner has misinterpreted claim 38, and that the finality of the rejection set forth in the current Office Action is premature, and should be withdrawn.

Respectfully submitted,

Wei-Ping CHEN et al.

By /Michael R. Davis/ Digitally signed by /Michael R. Davis/ DN: cn=/Michael R. Davis/, o=WLP, ou, email=mdavis@wenderoth.com, c=US Date: 2010.10.22 13:18:58 -04'00'

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